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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,842	07/30/2003	Hiroto Yoshikawa	43890-544	3723

7590 03/26/2007 McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096	EXAMINER
	KISS, ERIC B

ART UNIT	PAPER NUMBER
2192	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 July 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>*1-10*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>*1-10*</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>29 December 2003</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>20050504</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-10 have been examined.

Drawings

2.   Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that

which is old is illustrated. (Specification (07/30/2003) at p. 7); see MPEP § 608.02(g).

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office

action to avoid abandonment of the application. The replacement sheet(s) should be labeled

"Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion

of the drawing figures. If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The objection

to the drawings will not be held in abeyance.

Claim Objections

3.   Claims 4, 8, and 10 are objected to because of the following informalities: "host device"

in line 2 of each of claims 4, 8, and 10, should presumably read --said host device--. Appropriate

correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5.   Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 10 recites the limitation "The method of installing a software program in a host

device according to claim" in lines 1-2. There is insufficient antecedent basis for this limitation

in the claim. In the interest of compact prosecution, claim 10 is interpreted as referring to the

host device of claim 9.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No.

6,009,480 (Pleso).

As per claim 1, *Pleso* discloses: A method of installing a software program in a host

device (see, e.g., col. 3, lines 18-31 (method for installing a peripheral device driver to a

computer system)), said software program being required for said host device to communicate

with a peripheral device (see, e.g., Abstract (a device driver which the computing system

employs to communicate with the peripheral system)), said method comprising the steps of:

coupling said host device to said peripheral device (see, e.g., col. 3, lines 18-31

(connecting a peripheral device to a computer)) utilizing a USB serial interface, said peripheral

device containing said software program stored in a memory device contained in said peripheral

device (see, e.g., col. 3, lines 18-31 (the peripheral device including . . . a first memory . . .

storing the peripheral device driver));

uploading said software program from said peripheral device to said host device over said

USB serial interface (see, e.g., col. 3, lines 5-16 (the peripheral device downloads the device

driver to the second memory . . .); col. 11, lines 55-65 (USB)); and

installing said software program in said host device (see, e.g., col. 3, lines 5-16 (the

peripheral device downloads the device driver to the second memory . . .)) thereby allowing

communication between said host device and said peripheral device (see, e.g., Abstract (a device

driver which the computing system employs to communicate with the peripheral system)).

As per claim 2, *Pleso* further discloses said software program is a driver associated with

said peripheral device which allows for communication between said host device and said

peripheral device (see, e.g., col. 3, lines 18-31 (method for installing a peripheral device driver to

a computer system)).

As per claim 3, *Pleso* further discloses said software program is an application for

executing a functional operation associated with the operation of the peripheral device (see, e.g.,

col. 3, lines 18-31 (method for installing a peripheral device driver to a computer system)).

As per claim 4, *Pleso* further discloses said host device and said peripheral device

communicate with one another utilizing the USB specification (see, e.g., col. 11, lines 55-65).

As per claim 5, *Pleso* discloses: A method of installing a software program in a host

device (see, e.g., col. 3, lines 18-31 (method for installing a peripheral device driver to a

computer system)), said software program being required for said host device to communicate

with a peripheral device (see, e.g., Abstract (a device driver which the computing system

employs to communicate with the peripheral system)), said method comprising the steps of:

coupling said host device to said peripheral device (see, e.g., col. 3, lines 18-31

(connecting a peripheral device to a computer)) utilizing a USB serial interface, said peripheral

device containing said software program stored in a memory device contained in said peripheral

device (see, e.g., col. 3, lines 18-31 (the peripheral device including . . . a first memory . . .

storing the peripheral device driver));

[determining] if said host device comprises said software program in said memory device

contained in said host device (see, e.g., Figure 8 (step 252); col. 11, lines 7-10 (determines

whether a peripheral device driver is needed)) [and if not,] uploading said software program

from said peripheral device to said host device over said USB serial interface (see, e.g., col. 3,

lines 5-16 (the peripheral device downloads the device driver to the second memory . . .); col.

11, lines 55-65 (USB));

installing said software program in said host device (see, e.g., col. 3, lines 5-16 (the

peripheral device downloads the device driver to the second memory . . .)) thereby allowing

communication between said host device and said peripheral device (see, e.g., Abstract (a device

driver which the computing system employs to communicate with the peripheral system)).

As per claim 6, *Pleso* further discloses said software program is a driver associated with

said peripheral device, which allows for communication between said host device and said

peripheral device (see, e.g., col. 3, lines 18-31 (method for installing a peripheral device driver to

a computer system)).

As per claim 7, *Pleso* further discloses said software program is an application for

executing a functional operation associated with the operation of the peripheral device (see, e.g.,

col. 3, lines 18-31 (method for installing a peripheral device driver to a computer system)).

As per claim 8, *Pleso* further discloses said host device and said peripheral device communicate with one another utilizing the USB specification (see, e.g., col. 11, lines 55-65).

As per claim 9, *Pleso* discloses: A host device capable of communicating with any one of a plurality of peripheral devices utilizing a USB serial interface (see, e.g., col. 3, lines 18-31 (method for installing a peripheral device driver to a computer system); col. 11, lines 55-65 (USB)), each of said plurality of peripheral devices having the software driver necessary for communicating with a given peripheral stored in a memory device contained in said given peripheral (see, e.g., col. 3, lines 18-31 (the peripheral device including . . . a first memory . . . storing the peripheral device driver)), said host device comprising:

a USB interface capable of defining said host device as a master device relative to said plurality of peripheral devices, (see, e.g., col. 3, lines 18-31 (connecting a peripheral device to a computer); col. 11, lines 55-65 (USB));

a software driver uploader for uploading the software driver of a given one of said plurality of peripheral devices, which is coupled to said host device via said USB serial interface (see, e.g., col. 3, lines 5-16 (the peripheral device downloads the device driver to the second memory . . .); col. 11, lines 55-65 (USB)), and

a software driver installer for installing said software driver uploaded from said given one of said plurality of peripheral devices (see, e.g., col. 3, lines 5-16 (the peripheral device downloads the device driver to the second memory . . .)) so as to allow communication between said host device and said given one of said plurality of peripheral devices (see, e.g., Abstract (a device driver which the computing system employs to communicate with the peripheral system)).

As per claim 10, *Pleso* further discloses said host device and said given one of said

plurality of peripheral devices communicate with one another utilizing the USB specification

(see, e.g., col. 11, lines 55-65).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

9.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The

Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be

reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the

organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature should be directed to the TC 2100 Group receptionist:

571-272-2100.

Eric B. Kiss
March 22, 2007